

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

11000054-0033

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on October 27, 2009Signature /Sharon A. Smith/Typed or printed name Sharon A. Smith

Application Number

10/573,615

Filed

March 6, 2007

First Named Inventor

Walter Dennis Robertson III

Art Unit

3752

Examiner

James Sean Hogan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

<input type="checkbox"/>	applicant/inventor.	<u>/Nam H. Huynh/</u>	Signature
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>Nam H. Huynh</u>	Typed or printed name
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number <u>60-703</u>	<u>214-259-0971</u>	Telephone number
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>October 27, 2009</u>	Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Walter Dennis Robertson III

Application No.: 10/573,615

Confirmation No.: 9787

Filed: March 6, 2007

Art Unit: 3752

For: Valve Assembly

Examiner: Hogan, James Sean

PRE-APPEAL BRIEF

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants file this Pre-Appeal Brief in conjunction with a Notice of Appeal in response to the Final Office Action mailed on July 30, 2009. Applicants respectfully request reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks.

REMARKS/ARGUMENTS

Applicants have reviewed and considered the Final Office Action mailed on July 30, 2009, and the references cited therewith. In the Office Action, Claims 11, 13-17, 19 and 20 are rejected. Claims 11, 13, 17, 19 and 20 are rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 5,151,178 to Nickerson et al. (hereafter "Nickerson") in view of U.S. Patent No. 3,740,019 to Kessell et al. (hereafter "Kessell"). Claims 14-16 are rejected under 35 USC §103(a) as being unpatentable over Nickerson in view of Kessell and further in view of U.S. Patent No. 4,635,683 to Neilson (hereafter "Neilson").

Rejections under 35 U.S.C. § 103 - Standard

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. §103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight. *Ex parte Grasselli*, 231 USPQ 393

(Bd. App. 1983) aff'd mem. 738 F.2d 453 (Fed. Cir. 1984). In other words, all words in a claim must be considered in judging the patentability of that claim against the prior art. MPEP § 2143.03 (emphasis added). Further, rejections based on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Teleflex Inc. v. KSR Int'l Co.*, 550 U.S. at 1, 82 USPQ2d at 1396 (2007).

References Cannot Be Combined Where Reference Teaches Away from Their Combination.

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). MPEP § 2145.X.D.2.

The Office Action fails to establish a prima facie case of obviousness against 11, 13, 17, 19 and 20 because as clearly stated in the MPEP § 2145.X.D.2., "References Cannot Be Combined Where Reference Teaches Away from Their Combination" (emphasis added). The Office Action admits that Nickerson teaches away from the first guide spring being secured to the plunger distal end as recited in independent Claims 11 and 17. *See Office Action dated July 30, 2009, page 3, lines 1-2.* Therefore, as clearly stated in the MPEP, Nickerson CANNOT be combined with any reference or teachings where Nickerson teaches away from such combination. Accordingly, the Office Action reliance on Nickerson is improper. Consequently, the Office Action fails to establish a prima facie case of obviousness against 11, 13, 17, 19 and 20.

The Office Action Misapplies *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

In addition, the Office Action misapplies the ruling in *Howard* to applicants claimed invention. *See Office Action dated July 30, 2009, page 3, lines 3-5.* In *Howard*, the Court states that it is not an invention "to cast in one piece an article which had formerly been cast in two pieces and put together" (emphasis added). Even if, arguendo, the Examiner considers "a first guide spring being secured to a plunger distal end" as one piece (as recited in Claim 11), Nickerson does not disclose two pieces (i.e., a guide spring and a plunger) put together. Thus, the Office Action's reliance on *Howard* is in error.

Mere Statement That the Claimed Invention Is Within the Capabilities of One of Ordinary Skill in the Art Is Not Sufficient By Itself to Establish Prima Facie Obviousness, MPEP § 2143.01.IV.

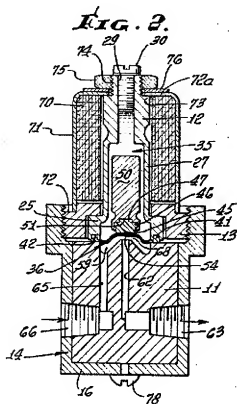
The Office Action statement that “the attachment of two items is obvious to one having ordinary skill in the art at the time of the invention was made” is not sufficient by itself to establish prima facie obviousness. *See Office Action dated July 30, 2009, page 3, lines 2-3.* First, the Office Action ambiguously states that “the attachment of two items is obvious” as opposed to the attachment of “a first guide spring to a plunger distal end” in valve assembly would be obvious. Further, the Office Action provides no support as to why the attachment of “a first guide spring to a plunger distal end” in valve assembly would be obvious to one of ordinary skill in the art at the time of the claimed invention. Therefore, the Office Action fails to provide some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness as required under KSR. Accordingly, for at least this additional reason, the Office Action Office Action fails to establish a prima facie case of obviousness against 11, 13, 17, 19 and 20.

The Office Action Fails to Address All Limitations of the Claims.

The Office Action fails to address Applicants prior claim amendments to Claims 11 and 17. In particular, Claims 11 and 17 recite “wherein the first sealing surface and the second sealing surface are substantially parallel when said plunger is in said open position” (emphasis added). The Office Action merely states that Applicants arguments are moot because Kessell exemplifies a parallel mating valve surfaces in both the open and closed positions. *See Office Action dated July 30, 2009, page 2, lines 1-4.* Applicants respectfully disagree that Applicants prior claim amendment is moot. Further, the Office Action fails to indicate how and/or where Kessell discloses “wherein the first sealing surface and the second sealing surface are substantially parallel when said plunger is in said open position” as recited in Claims 11 and 17. Therefore, for at least this additional reason, the Office Action Office Action fails to establish a prima facie case of obviousness against 11, 13, 17, 19 and 20.

The Combination of Nickerson and Kessell Does Not Disclose or Even Suggest All Limitations of the Claims.

A prima facie case of obviousness against 11, 13, 17, 19 and 20 cannot be establish because the combination of Nickerson and Kessell does not disclose or even suggest all limitations of the claims. As previously stated, Kessell does not disclose first and second sealing surfaces “wherein the first sealing surface and the second sealing surface are substantially parallel when said plunger is in said open position.” For instance, Kessell’s Figure 2 is depicted below that shows Kessell’s sealing member (i.e., diaphragm 36) as flexible material that can deform to any shape to maintain the volumetric capacity of chamber 35. (See Kessell, col. 4, lines 28-38).



As shown above, diaphragm 36 is flexible and may deform to varying shapes. Therefore, Kessell does not disclose or even suggest that a first sealing surface and the second sealing surface are substantially parallel when said plunger is in said open position as recited in Claims 11 and 17. More particularly, as noted in the detailed description of this application at paragraph [0016], the angled underside of diaphragm 36 in Kessell is undesirable because of the particle generation caused

when such angled underside is deformed, rendering the teachings of Kessel completely opposed to the teachings of the present application. Accordingly, prima facie case of obviousness against 11, 13, 17, 19 and 20 cannot be establish because the combination of Nickerson and Kessell does not disclose or even suggest all limitations of the claims.

In view of the above arguments, Applicants respectfully request the rejection to Claims 11, 13-17, 19 and 20 under 35 USC §103(a) be withdrawn.

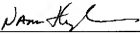
CONCLUSION

For the foregoing reasons, and for other apparent reasons, Applicants respectfully request reconsideration and favorable action. If the Examiner feels a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stand ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 19-3140, under Docket No. 11000054-0033, of Sonnenschein Nath & Rosenthal LLP from which the undersigned is authorized to draw.

Dated: October 27, 2009

Respectfully submitted,

By 

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